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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent No. 4,282,233

New York, New York

Inventor: Frank J. Villani

October 6, 1989

Issued: August 4, 1981

Assignee: Schering Corporation

For: ANTIHISTAMINIC 11-(4-PIPERIDYLIDENE)

5H-BENZO-[5,6]-CYCLOHEPTA-[1,2-B]-

PYRIDINES

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Hon. Commissioner of Patents and Trademarks

Washington, DC 20231

REQUEST FOR RECONSIDERATION OF EARLIER PETITION  
UNDER 37 C.F.R. §1.324 TO CORRECT INVENTORSHIP

Sir:

Petitioner respectfully requests reconsideration of the Decision on its Petition under 37 C.F.R. §1.324 to Correct Inventorship filed May 3, 1989. Petitioner respectfully submits that the declarations by Dr. Frank J. Villani and his former laboratory assistant, Mr. Charles V. Magatti, sufficiently set forth facts justifying the granting of the petition to correct inventorship under 37 C.F.R. 1.324.

For convenience of reference copies of the original declarations by Dr. Villani and Mr. Magatti are attached hereto as Exhibits 1 and 2. Reference to Exhibit 1, the declaration of Dr. Villani, reveals that Dr. Villani is a retired chemist and a former employee of Schering Corporation. Dr. Villani, in paragraph 3 of his declaration, explains that his laboratory assistant, Mr. Magatti, unexpectedly obtained a certain chemical product designated SCH 25548 while conducting certain tests which Dr. Villani had requested. That is, the compound known as SCH 25548, was obtained as a result of work performed at Dr. Villani's request, although the objective of the assigned work was not to make SCH 25548.

Dr. Villani proceeds to explain in paragraph 3 of his declaration that he first was under the impression that he had made this compound earlier at Schering. It was only sometime thereafter that Dr. Villani realized that he had not actually earlier made that compound himself and that the preparation of SCH 25548 was in fact first reported to him by Mr. Magatti.

Since Dr. Villani is a research chemist and not a lawyer, he cannot be expected to have made a determination as to inventorship. The point is simply that although Dr. Villani does not indicate in his declaration and apparently may not recall at this time the precise moment that he first recognized that he had not personally made this particular compound before Mr. Magatti, it does not follow that Dr. Villani knew or even should have

known that this fact was important in the determination of inventorship. Who is or is not an inventor is a legal conclusion that even many lawyers may rightfully argue.

Dr. Villani recites in paragraph 4 of his declaration that in the course of a more recent review, he was advised by counsel that Mr. Magatti's synthesis of SCH 25548 occurred under circumstances which constituted an inventive contribution and thus would require adding Mr. Magatti's name as a co-inventor. The undersigned, attorney for petitioner, is personally familiar with that more recent review and participated in such review and rendered an opinion during the early part of 1989. The petition to correct inventorship was filed promptly thereafter.

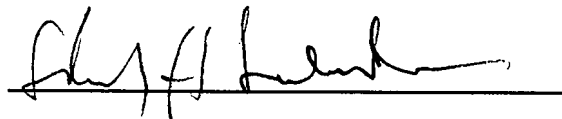
Once more it should be noted that whether an individual is a co-inventor is, in the final analysis, no more than a matter of legal opinion based on an application of the law to the facts. Dr. Villani apparently relied on the advice of the undersigned as well as counsel at Schering that his laboratory assistant, Mr. Magatti, did not merely serve as "a pair of hands" with respect to SCH 25548. Thus Dr. Villani's declaration specifically recites that "I have been advised by counsel that these acts performed by Mr. Magatti amount to an inventive contribution to SCH 25548."

In conclusion it is respectfully submitted that under the circumstances described above, Dr. Villani acted promptly in

the filing of his declaration to correct inventorship. It is clear from Dr. Villani's declaration that his acknowledgment of the error in inventorship is based on the advice of counsel arising from a review of the facts which was recent in terms of the date of Dr. Villani's declaration, i.e. April 20, 1989. Thus, as stated in the Petition, the error in the original naming of inventor was necessarily without deceptive intent since Dr. Villani was first advised of the error in early 1989. The facts and circumstances underlying the legal conclusion arrived at by counsel, including this counsel, are not so unequivocal that Dr. Villani could or should have earlier known that his laboratory assistant, Mr. Magatti, was a co-inventor.

For the foregoing reasons, it is once more respectfully requested that the original petition to correct inventorship under 37 C.F.R. §1.324 should be reconsidered and granted.

Respectfully submitted,



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